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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,424	02/22/2002	Jan Isaksson	23027	1026

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EXAMINER

MITCHELL, JAMES M

ART UNIT PAPER NUMBER

2827

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,424

Applicant(s)

ISAKSSON, JAN

Examiner

James Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) 12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Election

Applicant's election of claims 1-19 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how driver further limits the scope of a circuit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 10,11, 14,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spath (U.S 5,925,898).

Spath discloses a method of making an active optical device for coupling to an external light guide, comprising the steps of providing a substrate (1) with a light path therethrough and having a front face and a rear face, providing a components (9) for attachment to the rear face of the substrate, said component having a face presenting an array of inherent contacts (region of chip in contact with item 12), wherein at least one flip chip bonding active optical component consist of a light emitter, receiver (Fig 3; Column 4, Line 19) or VCSEL (Column 3, Lines 3-36), forming a plurality of contact (12) on the rear surface of said transparent substrate (Claim 3) at precisely defined locations corresponding to an intended location of the contacts of each component, said at least one optical component being oriented so that it can be optically coupled through the substrate to the external light guide (17; Column 4, Line s 24-26); and the substrate is transparent to an operating wavelength of the device to permit light to pass therethrough (Abstract), positioning inherent plurality of pads on a rear (top and bottom backside surfaces of the substrate) attaching a guide frame (18,20) to said substrate with the pads comprised of solder (Column 5, Line 5), wherein the solder pads (26) are arranged in opposed pairs extending on either side of a line (defined by opening), said substrate is made of glass or sapphire (Column 3, Lines 36-37); inherent holes provided

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in substrate to permit light pass through; said frame including indicia marking (via opening, 19) inherently marking the location of guide pins for said external light guide; said guide frame including wing overhanging side edges of said substrate.

Spath does not appear to explicitly disclose a plurality of components. However, Spath discloses the claimed invention except for plurality of components. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a plurality of components, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Co. v. Bemis*, 193 USPQ 8 (CA7 1977).

With respect to claim 4 and the guide frame serving to locate guide pin for said external light guide Although Spath does not appear to explicitly teach this statement of intended use, the statement of intended use does not result in a structural difference between the claimed apparatus and the apparatus of prior art. Further, because the apparatus of the prior art is inherently capable of being used for the intended use the statement of intended use does not patentably distinguish the claimed apparatus from the apparatus of prior art. Similarly, the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus; *Ex parte Wikdahl* 10 USPQ 2d 1546, 1548 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889, 1891 (BPAI 1988); *In re Finsterwalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235, 238 (CCPA 1967). Also, "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim."; *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). And, "Inclusion of material or

article worked upon by a structure being claimed does not impart patentability to the claims."; In re Young, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 136 USPQ 458, 459 (CCPA 1963)). And, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Claims 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spath as applied to claims 1 and 18 and further in combination with Makiuchi et al. (U.S. 5,436,997).

Spath does not appear to disclose a heat sink on the front side thereof facing the rear face of said substrate including guide pins; however, Makiuchi (Fig 11) utilizes a heat sink on the front side thereof facing the rear face of said substrate including guide pins (via flange portion of sink).

It would have been obvious to one of ordinary skill in the art to incorporate a heat sink on the front side thereof facing the rear face of said substrate of Spath in order to decrease formation of the frame as taught by Makiuchi (Column 9, Lines 49-51).

Allowable Subject Matter

Claims 12 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose or make obvious the guide frame made of nickel or that the frame contains holes to

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permit a guide pin protruding from the heat sink to pass through with said holes being located in the wing portion of said guide frame including all the limitations of the independent claim.

Conclusion

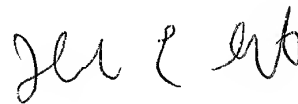
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mitchell whose telephone number is (703) 305-0244. The examiner can normally be reached on M-F 10:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



jmm
November 21, 2002



DAVID E. GRAYBILL
PRIMARY EXAMINER